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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re World of Floors USA, Inc.

Serial No. 76/080,436

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Krass, Groh, Sprinkle, Anderson & Citkowski, P.C. for World
of Floors USA, Inc.

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108 (David E. Shallant, Managing Attorney).

Before Simms, Seeherman and Chapman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

World of Floors USA, Inc. has applied to register
WORLD OF FLOORS and design, as shown below, as a mark for
"retail store services featuring floor coverings, namely,
carpet, tile, wood, rugs and other types of flooring."¹ The

¹ Application Serial No. 76/080,436, filed June 26, 2000. The
application is based on Section 1(a) of the Act, and asserts
first use and first use in commerce as of May 1998.

mark is described as consisting "of the words 'WORLD OF FLOORS' plus the design of a globe with meridians and parallels only," and exclusive rights to the word FLOORS have been disclaimed.



The Examining Attorney has issued a final refusal of registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), asserting that applicant's mark so resembles the mark FLOOR WORLD, previously registered for "retail store services in the field of carpeting, rugs, tiles, and other floor coverings,"² that, as used in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive.

Applicant has appealed from the refusal, and both applicant and the Examining Attorney have filed appeal briefs. Applicant had originally requested an oral hearing, but subsequently withdrew that request.

We affirm the refusal of registration.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative

facts in evidence that are relevant to the factors set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the services, they are legally identical. Both are for retail store services featuring floor coverings. In fact, the respective identifications enumerate many of the same types of floor coverings, i.e., carpet, tile and rugs. When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In this case, the marks are very similar, indeed. Applicant's mark is WORLD OF FLOORS with a design of a globe; the cited mark is FLOOR WORLD. The marks are similar in appearance and pronunciation, with both containing the same words WORLD and FLOOR[S]. The Persian

² Registration No. 1,449,060, issued July 21, 1987; Section 8 affidavit accepted; Section 15 affidavit received.

lettering in applicant's mark does not serve to distinguish the marks, since the cited mark is registered as a typed drawing, and thus its protection extends to a depiction in the same Persian letter font as applicant's. Nor does the globe design distinguish applicant's mark from the cited registration. In general, design elements are entitled to lesser weight in the likelihood of confusion analysis because it is by the word portion that purchasers refer to the goods or services. **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987); see also, **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, moreover, the globe design merely reinforces the commercial impression of the word "WORLD" in applicant's mark.

The word order of the marks is, of course, reversed, but again, this does not serve to distinguish them. Under actual marketing conditions consumers do not generally have the opportunity to make side-by-side comparisons of marks, but must rely on hazy past recollections. See **Dassler KG v. Roller Derby Skate Corporation**, 206 USPQ 255 (TTAB 1980). Because the meaning of the marks WORLD OF FLOORS and FLOOR WORLD is the same, consumers are not likely to remember, upon encountering applicant's WORLD OF FLOORS and

design mark, that it is different from the registrant's FLOOR WORLD mark.

Viewing the marks in their entirety, we find that they are similar in appearance, pronunciation and connotation, and that they convey the same commercial impressions.

Thus, the present situation differs from those in the cases cited by applicant. For example, in **In re Akzona Inc.**, 219 USPQ 94 (TTAB 1983), the Board found no likelihood of confusion between SILKY TOUCH for synthetic yarns and TOUCH O'SILK for items of men's clothing because of the differences in the goods and the differences in the commercial impressions of the marks. In particular, the Board found that "'SILKY TOUCH,' conveys the impression that applicant's synthetic yarns are silky to the touch" while "'TOUCH O' SILK,' suggests that registrant's clothing products contain a small amount of silk." Id. at 96.

Similarly, in **In re Best Products Co.**, 231 USPQ 988 (TTAB 1986), the Board found no likelihood of confusion between BEST JEWELRY and design for retail jewelry store services and JEWELERS' BEST for bracelets and watch bracelets, because of the differences in the goods and services and the differences in the commercial impressions of the marks. The Board stated, at 231 USPQ 990:

The mark JEWELERS' BEST connotes a selection of jewelry reflecting a quality level perceived by the jeweler personally, i.e., it says, "These watch bracelets are the best that jewelers can offer --" a purely laudatory expression. It is also a unitary expression in that neither "jewelers'" nor "best" stands by itself. On the other hand, BEST JEWELRY consists of the house mark "Best" coupled with the generic name of the services.

In the present case, on the other hand, not only are the services of applicant and the registrant identical, but the commercial impressions of the marks, despite the reversal of the words, is the same. Applicant has certainly not pointed to any difference in meaning that results from the reversal, and in our view the meanings of the marks are identical. Thus, the present situation is more akin to cases in which the Board found likelihood of confusion because, as the Board explained in **In re Best Products Co., Inc., Id.** at 989:

ordinary prospective purchasers, not being infallible in their ability to recall trade designations, may transpose the elements in their minds and, as a result, mistakenly purchase the wrong products or engage the wrong services. See, e.g., Bank of America National Trust and Savings Association v. American National Bank of St. Joseph, 201 USPQ 842, 845 (TTAB 1978) [BANKAMERICA v. AMERIBANC, both for banking services.] In re General Tire & Rubber Co., 213 USPQ 870, 871 (TTAB

1982) [SPRINT STEEL RADIAL v. RADIAL
SPRINT, both for tires.]

Applicant also argues that there is extensive third-party use of the word "WORLD" in connection with identical goods and services, as a result of which the scope of protection of the cited registration should be limited. We agree that the cited registration, consisting of the descriptive and disclaimed word FLOOR and the suggestive word WORLD, is a suggestive mark which is entitled to a relatively narrow degree of protection. However, applicant's mark, which also consists of the descriptive word FLOORS and the suggestive word WORLD, is similarly suggestive in meaning, as well as being similar in appearance and pronunciation, and it is used in connection with identical services. The likelihood of confusion is to be avoided as much between "weak" marks as between "strong" marks. **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974). Thus, even suggestive marks are entitled to protection against the use of extremely similar marks for identical services, and that is the situation we have here.

Applicant also cites **King Candy Company v. Eunice King's Kitchen, Inc.**, supra at 182 USPQ 110, for the proposition that for marks which are "of such non-arbitrary

nature or so widely used...the public easily distinguishes slight differences in the marks under consideration as well as differences in the goods." Applicant's support for its contention that the marks are widely used are excerpts taken from the Internet for such marks as "World of Carpets," "Carpet World Ltd," "Carpet World of Alaska," and "Carpet World USA." The problem with this evidence is that none of these listings is for the cited mark, FLOOR WORLD, or for any mark containing the word FLOOR; therefore, we cannot say that the public has been exposed to the use of third-party FLOOR WORLD marks to such an extent that they would distinguish WORLD OF FLOORS and design from other FLOOR WORLD marks by such a minor difference as a reversal of the words and the inclusion of the design of the world. We would also point out that the third-party uses appear, from the materials of record, to be rather localized, and there is no indication that the public within a particular geographic area is exposed to more than one third-party use. For example, the "World of Carpets Decorating Center" website refers to the company as the largest showroom north of San Francisco; "Carpet World Ltd.'s" website states that the store is located in Lubbock, Texas; "Carpet World of Alaska" appears to be located in that state; and the

website of "Carpet World USA" states that the company has two stores, both in Tennessee.³

Finally, applicant's and the registrant's services are offered to the same classes of customers, the public at large. Such consumers are likely to assume, when such similar marks as WORLD OF FLOORS and design and FLOOR WORLD are used in connection with identical services, that the services emanate from the same source. As a result, confusion as to source is likely.

Decision: The refusal of registration is affirmed.

³ Other excerpts submitted by applicant are even less persuasive of third-party use. The website for "World Rugs" appears to be a general information website for people interested in oriental rugs, rather than a store; "World Class Carpet" clearly has a different commercial impression from "World Carpet" or "Carpet World" let alone FLOOR WORLD or WORLD OF FLOORS; and another excerpt with the subheading of "Cut/Uncut Styles from World Carpet" is from the website of iFLOOR.com.